THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKEHIKO HAMADA

Appeal No. 2001-2642
Application No. 09/057,455

ON BRIEF

Before KIMLIN, KRATZ and MOORE, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of this appeal leads us to conclude that this case is not in condition for a decision at this time. Accordingly, we remand this application to the examiner to consider the following issues and to take appropriate action.

This appeal was taken pursuant to 35 U.S.C. § 134 from the final rejection of claims 1-20, which are all of the claims pending in this application.

Appellant's invention relates to a position detecting system and method.

In the final rejection mailed May 18, 2000, the examiner maintained six separate rejections: (1) a rejection of claims 6, 12 and 20 under the second paragraph of 35 U.S.C. § 112; (2) a § 103 rejection of claims 1-4 and 7-10 over Munakata in view of Kato et al. and Ichihashi et al. as set forth in a previous office action; (3) a § 103 rejection of claims 5 and 11 over Munakata in view of Kato et al., Ichihashi et al. and Todokoro et al. as set forth in a previous office action; (4) a § 102 rejection of claim 15 as being anticipated by Peckerar et al.; (5) a § 103 rejection of claims 13, 14 and 16-18 as being unpatentable over Munakata in view of Kato et al., Ichihashi et al. and Peckerar et al.; and (6) a § 103 rejection of claim 19 as being unpatentable over the combined teachings of Munakata, Kato et al., Ichihashi et al., Todokoro et al. and Peckerar et al.

In the brief filed on April 18, 2001, appellant indicated that the rejection(s) of claims 1-14 would not be contested but the

rejection(s) pertaining to claims 15-20 would be contested. However, appellant only furnished arguments as to the examiner's separate rejections of claims 15 and 20. Hence, the brief left the other rejections set forth in the final that pertained to claims 16-19 unanswered.

In the answer mailed May 31, 2001, the examiner presents separate rejections of claims 15 and 20 for our review and agrees with appellant's statement of the status of the claims and issues in the brief.

As a consequence, the issues have not been fully developed and joined by appellant and the examiner for our review in making a decision in this appeal. In particular, we note that the examiner has not explained which, if any, of rejections (1), (2), (3), (5) and (6), as labeled above and as presented in the final rejection were intended to be maintained against yet pending claims 1-14 and 16-19.

To the extent the examiner did not intend to indicate the allowableness of claims 1-14 and 16-19, we note that the Manual of Patent Examining Procedure (MPEP) § 1206 at page 1200-8 et seq. provides that the examiner should afford appellant an opportunity

to furnish arguments as to any grounds of rejection that have not been addressed in the brief by forwarding a Notification of Non-Compliance with 37 CFR § 1.192(c) to appellant. See 37 CFR § 1.192(d). Of course, any rejections that the examiner intended to maintain should have been repeated in the answer.

This application is remanded to the examiner for resolution of the above-noted matters as to the status of claims 1-14 and 16-19 and the rejections set forth in the final rejection that pertained thereto.

Under the circumstances recounted above, the record before us is not in a condition which permits a proper disposition of the subject appeal. We are constrained, therefore, to remand this application to allow for the clarification of the file record by both the examiner and appellant with respect to all of the rejections previously advanced by the examiner in the final rejection. It is our determination that a supplemental examiner's answer will not effect the record clarification necessary in this case. As a consequence, we do not authorize a supplemental answer under 37 CFR § 1.193(b)(1)(1999) as an appropriate response to this remand.

This application, by virtue of its "special" status, requires an immediate action. See Manual of Patent Examining Procedure § 708.01 (8th ed., August 2001). It is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

EDWARD C. KIMLN
Administrative Patent Judge

PETER F. KRATZ
Administrative Patent Judge

JAMES MOORE
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

PFK:psb

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